

Attorney Docket Number: FSP0359
Title: provide set top box configuration for content on demand
Application Number: 10/579,097

REMARKS

In an office action mailed on 01/12/2009, an election is required among five allegedly distinct species described in the claims. The species which alleged are distinct are group 1, claims 1-5; group 2, claims 6-10; group 3, claims 11-13; group 4, claims 14-17; and group 5, claims 18-19.

The Applicant hereby elects Group 2 for continued prosecution, with traverse. The Applicant first respectfully asserts that the mere allegation of a common non-inventive technical feature, standing alone, is not sufficient to support a restriction among the claims.

The Inventions are Not Distinct Under MPEP § 802

Groups I and II are related as a combination and subcombination. To support a requirement for restriction between combination and subcombination inventions, both two-way distinctness and reasons for insisting on restriction are necessary, i.e., there would be a serious search burden as evidenced by separate classification, status, or field of search. See MPEP § 808.02. To be distinct the claims must cover inventions that (A) do not require the particulars of the subcombination as claimed for patentability (to show novelty and unobviousness), and (B) the subcombination can be shown to have utility either by itself or in another materially different combination.

As a threshold matter, the Examiner has failed to demonstrate (B), specifically,

that in a combination including

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logic to compose set top box configuration information into an audio and/or video stream format,
and to communicate the configuration information to a plurality of set top boxes,

that the subcombination including

logic to communicate the configuration information to a plurality of service nodes,
the service nodes each composing a service group identifier into the audio and/or video stream format,

has utility either by itself or in another materially different combination.

Groups 1 and 3 are related as a combination and subcombination. To be distinct the claims must cover inventions that (A) do not require the particulars of the subcombination as claimed for patentability (to show novelty and unobviousness), and (B) the subcombination can be shown to have utility either by itself or in another materially different combination.

As a threshold matter, the Examiner has failed to demonstrate (B), specifically,

that in a combination including

logic to compose set top box configuration information into an audio and/or video stream format,
and to communicate the configuration information to a plurality of set top boxes,

that the subcombination including

a set top box tuning to a channel comprising configuration information having a streamed audio and/or video format, to

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read the configuration information, and to store the configuration information in memory,

has utility either by itself or in another materially different combination.

Groups 1 and 4 are related as a combination and subcombination. To be distinct the claims must cover inventions that (A) do not require the particulars of the subcombination as claimed for patentability (to show novelty and unobviousness), and (B) the subcombination can be shown to have utility either by itself or in another materially different combination.

As a threshold matter, the Examiner has failed to demonstrate (B), specifically,

that in a combination including

logic to compose set top box configuration information into an audio and/or video stream format,
and to communicate the configuration information to a plurality of set top boxes,

that the subcombination including

a set top box tuning to a predetermined virtual channel number to retrieve set top box configuration information formatted as an audio and/or video stream, and applying the configuration information to affect operational settings of a set top box,

has utility either by itself or in another materially different combination.

Groups 1 and 5 are related as a combination and subcombination. To be distinct the claims must cover inventions that (A) do not require the

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particulars of the subcombination as claimed for patentability (to show novelty and unobviousness), and (B) the subcombination can be shown to have utility either by itself or in another materially different combination.

As a threshold matter, the Examiner has failed to demonstrate (B), specifically,

that in a combination including

logic to compose set top box configuration information into an audio and/or video stream format,
and to communicate the configuration information to a plurality of set top boxes,

that the subcombination including

a set top box tuning to a channel comprising set top box configuration information having a streamed audio and/or video format, and locating among the configuration information a service group identifier for a set top box and a channel and an alternate channel from which to retrieve a content index having the streamed audio and/or video format, and tuning to the channel from which to retrieve the content index to retrieve the content index, and tuning to the alternate channel when the channel from which to retrieve the content index comprises an indication of invalid data,

has utility either by itself or in another materially different combination.

Conclusion

The Applicant, being required to do so, has elected one group of claims (Group 2) for continued prosecution. The Applicant has made clear

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in traverse why he believes the restriction is not proper. The Applicant thanks the Examiner for consideration of this application.

Signature /Charles A. Mirho/

Date: 2/17/2009

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